

PATENT

Application # 10/774,718

Attorney Docket # 2003-0029 (1014-058)

## REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the following remarks.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 are in independent form.

**The Obviousness Rejections**

Each of claims 1, 6-12, and 14-20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Loomis (U.S. Patent No. 5,625,668), Kepler (U.S. Patent No. 6,748,225), and Chern (U.S. Patent No. 6,456,854). These rejections are respectfully traversed.

**A. *Prima Facie* Criteria**

The applied references do not establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See*, MPEP § 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

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**A. No Motivation or Suggestion to Combine Applied References**

“When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

The present Office Action presents no evidence whatsoever that any of the applied references provide a suggestion or motivation for a combination with any of the other applied references.

**Loomis with Kepler**

*Inter alia*, each of independent claims 1, 19, and 20 recite, yet Loomis fails to expressly or inherently teach or suggest, “requesting from the user verification of the current location of the user-operated telecommunications device.” The present Office Action purports to find each of these limitations, admittedly missing in Loomis, by combining Loomis with Kepler.

Regarding the proffered combination of Loomis and Kepler, the present Office Action recites, “[i]t would have been obvious to an artisan of ordinary skill to incorporate such user

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verification, as taught by Kepler, within the method of Loomis in order to ensure that a correct current location is provided to the user." *See, Page 2.*

Loomis allegedly recites the "invention relates generally to navigation systems and mobile telephone systems and more specifically to combinations of navigation and cellular telephone instruments that can automatically report a mobile phone location in street address and other non-traditional location formats." See, col. 1, lines 6-10. Regarding the "mobile phone location," Loomis "can provide two to five meter accuracy." *See, col. 3, lines 52-54.*

Kepler allegedly recites a "system and method for determining a current location by the visual identification of retail signage and other readily recognizable landmarks comprising a service center having one or more service agents, a plurality of inbound communication channels allowing the service center to receive a communication from a lost traveler or a traveler unfamiliar with the particular locale, a switch platform in the service center directing the communication received from the traveler to one of the one or more service agents. The lost traveler identifies for the service agent one or more of landmarks the traveler sees proximate to the traveler's current location. A database is maintained which includes a plurality of records corresponding to the geographic location information for a plurality of landmarks in a given region. A host computer executes a search of the database for the one or more landmarks visually identified by the traveler. The host computer attempts to determine the current geographic location from a search of the database. If successful, the service provider provides to the traveler an indication of the traveler's current location." *See, Abstract.*

If Loomis can "automatically report a mobile phone location" with a "two to five meter accuracy", why would one having ordinary skill in the art look to Kepler's crude approach in which a "lost traveler identifies for the service agent one or more of landmarks the traveler sees proximate to the traveler's current location"? That is, why does the location accuracy indicated in Loomis not render superfluous any motivation to "identif[y] for the service agent one or more of landmarks the traveler sees proximate to the traveler's current location"?

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Moreover, how would such a combination "ensure that a correct location is provided to the user" as asserted in the Office Action? If Loomis' "automatically report[ed]" "mobile phone location" is not "correct", what teaching does Kepler provide for preventing that incorrect "automatically report[ed]" "mobile phone location" from being provided to the user?

**Chern with Kepler**

Claim 2 recites, yet even Loomis and Kepler taken together fail to expressly or inherently teach or suggest, "receiving a communications address of the user-associated telecommunications device."

Claim 3 recites, yet even Loomis and Kepler taken together fail to expressly or inherently teach or suggest, "receiving a communications address of the user-associated telecommunications device from the user."

Claim 4 recites, yet even Loomis and Kepler taken together fail to expressly or inherently teach or suggest, "receiving at an Internet site a communications address of the user-associated telecommunications device."

Claim 5 recites, yet Loomis fails to expressly or inherently teach or suggest, "recording a communications address of the user-associated telecommunications device."

Claim 13 recites, yet Loomis fails to expressly or inherently teach or suggest, "via wireless packet data, providing to the user-operated telecommunications device information indicative of the current location of the user-associated telecommunications device."

In order to correct the deficiencies of Loomis and Kepler, the present Office Action proposes an additional combination with Chern.

As stated above, Kepler allegedly recites a "system and method for determining a current location by the visual identification of retail signage and other readily recognizable landmarks comprising a service center having one or more service agents, a plurality of inbound communication channels allowing the service center to receive a communication from a lost

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**traveler or a traveler unfamiliar with the particular locale, a switch platform in the service center directing the communication received from the traveler to one of the one or more service agents. The lost traveler identifies for the service agent one or more of landmarks the traveler sees proximate to the traveler's current location. A database is maintained which includes a plurality of records corresponding to the geographic location information for a plurality of landmarks in a given region. A host computer executes a search of the database for the one or more landmarks visually identified by the traveler. The host computer attempts to determine the current geographic location from a search of the database. If successful, the service provider provides to the traveler an indication of the traveler's current location.” See, Abstract.**

By contrast, Chern allegedly recites that a “system and method for locating mobile telephone devices via the Web.” See, Abstract.

Why would one skilled in the art be motivated to combine these two references? Why, would the “lost traveler” in Kepler, after receiving “an indication” of her “current location” desire to locate her “mobile telephone” device “via the Web”?

The present Office Action fails to provide any evidence regarding any suggestion or motivation to combine Chern with Loomis and Kepler. Instead, the present Office Action makes a conclusory assertion that “[i]t would have been obvious to an artisan of ordinary skill to incorporate such location tracking over the Internet, as taught by Chern, within the method of Loomis and Kepler as additional use of a mobile telephone's current location.” See, Page 4.

**Conclusion – Motivation or Suggestion to Combine References**

Thus, the present Office Action fails to provide any evidence, or even a plausible argument, that the prior art provides any suggestion or motivation to combine the applied references. Accordingly, the combination of Loomis with Kepler and/or Chern is impermissible.

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**B. Obviousness Summary**

Thus, there is no motivation or suggestion to combine Loomis with Kepler and/or Chern to arrive at the claimed subject matter.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

**Allowable Subject Matter**

The following is a statement of reasons for the indication of allowable subject matter:

"none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-18, and 20 are allowable because none of the references of record alone or in combination disclose or suggest 'requesting from the user verification of the current location of the user-associated telecommunications device'; and

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claim 19 is allowable because none of the references of record alone or in combination disclose or suggest 'means for requesting from the user verification of the current location of the user-operated telecommunications device.'"

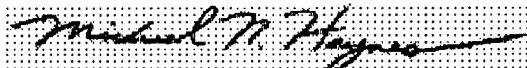
**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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